

R E M A R K S

Claims 1, 3 to 6, 8 to 10, 13 and 14 as set forth in Appendix in the Listing of Claims are currently pending in this case. Claim 11 has been canceled, Claim 3 has been amended, and Claim 14 has been added as indicated.

Claim 11 was withdrawn from consideration by the Examiner as being drawn to a patentably distinct invention and, accordingly, applicants have canceled Claim 11. Applicants preserve the right to pursue the canceled subject matter in a divisional application under Section 121. Claim 3 has been revised based on applicants' disclosure on page 4, indicated lines 1 to 7, of the application, and new Claim 14 has been added to further bring out an embodiment of applicants' invention as disclosed on page 4, indicated lines 33 to 35, of the application. No new matter has been added.

In light of applicants' cancellation of Claim 11 is is respectfully requested that the restriction requirement be withdrawn.

The Examiner takes the position that the Declaration which applicants submitted upon filing of the request for continued examination is insufficient to establish non-obviousness of the claimed subject matter in view of the new ground of rejection which were raised by the Examiner in the most recent Office action. The Examiner's new grounds of rejection are

- (a) the rejection of Claims 1, 3, 4 and 8 to 10 under 35 U.S.C. §103(a) as being unpatentable in light of the teaching of *Johnson* (US 5,139,854) when taken in view of the disclosure of *Klapper et al.* (US 5,312,848)<sup>1</sup>;
- (b) the rejection of Claims 1, 3 to 5, 8 and 13 under 35 U.S.C. §103(a) as being unpatentable in light of the teaching of *Ellison et al.* (US 5,342,666) when taken in light of the disclosure of *Johnson* and further in view of the disclosure of *Klapper et al.*<sup>2</sup>;
- (c) the rejection of Claim 5 under 35 U.S.C. §103(a) as being unpatentable in light of the teaching of *Johnson* when taken in view of the disclosure of *Klapper et al.* and further in view of the

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1) Issue (2), page 4 et seq., of paper 21.

2) Issue (3), page 6 et seq., of paper 21. A corresponding rejection based on the teaching of *Ellison et al.* in view of the disclosure of *Johnson* was raised in paper No. 13, but was withdrawn by the Examiner in paper No. 15.

disclosure of *Miyakoshi et al.* (US 5,827,788)<sup>3</sup>); and  
(d) the rejection of Claim 6 under 35 U.S.C. §103(a) as being unpatentable in light of the teaching of *Johnson* when taken in view of the disclosure of *Klapper et al.* and further in view of the disclosure of *Pelzer* (US 6,019,923)<sup>4</sup>).

The new grounds of rejection differ from the earlier rejections<sup>5</sup>) in that the disclosure of *Klapper et al.* is included as a secondary reference. The *Klapper et al.* reference is applied in the new grounds of rejection by the Examiner for its teaching that form parts for interior finishing applications may have "facers" or decorative layers on one side or on both sides. In contrast to the new grounds of rejection, the Examiner previously took the position<sup>6</sup>) that a mere duplication of parts has no significance unless new and unexpected results are produced, citing the Court's respective holding in *In re Harza* (274 F.2d 669, 124 USPQ 378 (CCPA 1960)) as precedent.

The Declaration which applicants submitted upon filing of the request for continued examination addresses a series of investigations and compiles numerous results of such investigations which show that the presence of a decorative layer on both sides of the backing layer in accordance with applicants' invention provides for a significant improvement in the tensile modulus of the layered composite. The significant increase in the tensile modulus which is achieved in accordance with applicants' invention is, as pointed out in applicants' preliminary remarks<sup>7</sup>), neither suggested by the teaching of *Johnson*, the disclosure of *Miyakoshi et al.* or the disclosure of *Pelzer*. The respective effect is equally not taught or implied by the teaching of *Ellison et al.* or the disclosure of *Klapper et al.* and, as such, the Examiner's inclusion of *Klapper et al.* as a (further) secondary reference does not change the factual circumstances. More importantly, the investigations reported in applicants' Declaration and the respective data presented by applicants are as pertinent to the new grounds of rejection as they were to the rejections previous-

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3) Issue (4), page 9, of paper 21.

4) Issue (5), page 9 et seq., of paper 21.

5) Office action of April 25, 2003, paper No. 15, Issue Nos. 9 to 11, and Office action dated September 25, 2002, paper No. 13, Issue Nos. 9 to 12. Applicants' respective remarks in the submissions dated February 19, 2003 (date of the Certificate of Mailing; paper No. 14), and October 24, 2003 (date of the Certificate of Mailing; paper No. 19), are herewith incorporated by reference.

6) Paper No. 15 in conjunction with paper No. 13.

7) Submission filed along with the request for continued examination.

ly raised by the Examiner. It is well established that the ultimate determination of patentability is based on the entire record with due consideration of any arguments and any secondary evidence<sup>8)</sup>. The Examiner's position that applicants' Declaration is insufficient in light of the new grounds of rejection clearly fails to properly appreciate the full record and the evidence already presented by applicants. The Examiner's position is therefore deemed to be in error. The data presented in applicants' Declaration clearly corroborate that applicants' invention as a whole was not prima facie obvious in light of the referenced art at the time applicants' made their invention. AS explained by the Courts, the invention as a whole which is referred to in Section 103(a) is not limited to the combination of features which is specifically recited in the claims but equally includes the properties and results which are inherent in the recited combination of features<sup>9)</sup>. The Examiner clearly fails to properly appreciate the properties and results of applicants' combination of features in her determination under Section 103(a), and accordingly fails to appreciate applicants' invention as a whole as is necessary in a determination under Section 103(a). The conclusion which is reached by the Examiner in her determination is therefore not deemed to be well taken.

In light of the foregoing, applicants respectfully request that the rejection under Section 103(a)

- (a) of Claims 1, 3, 4 and 8 to 10 as being unpatentable in light of the teaching of **Johnson** when taken in view of the disclosure of **Klapper et al.**;
- (b) of Claims 1, 3 to 5, 8 and 13 as being unpatentable in light of the teaching of **Ellison et al.** when taken in light of the disclosure of **Johnson** and further in view of the disclosure of **Klapper et al.**;
- (c) of Claim 5 as being unpatentable in light of the teaching of **Johnson** when taken in view of the disclosure of **Klapper et al.** and further in view of the disclosure of **Miyakoshi et al.**; and
- (d) of Claim 6 as being unpatentable in light of the teaching of **Johnson** when taken in view of the disclosure of **Klapper et al.**

8) In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (CAFC 1992).

9) In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); see also ; In re Wright, 848 F.2d 1216, 6 USPQ2d 1959 (CAFC 1988), overruled on other grounds in In re Dillon, 919 F.2d 688, 16 USPQ2d 1897 (CAFC 1990) (en banc), cert. denied 500 U.S. 904 (1991).

and further in view of the disclosure of *Pelzer*,  
be withdrawn. Favorable action is solicited.

REQUEST FOR EXTENSION OF TIME:

It is respectfully requested that a one month extension of time  
be granted in this case. A check for the \$110.00 fee is attached.

Please charge any shortage in fees due in connection with the  
filing of this paper, including Extension of Time fees, to Deposit  
Account No. 11.0345. Please credit any excess fees to such deposit  
account.

Respectfully submitted,

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Encl.: THE LISTING OF CLAIMS (Appendix I)

HBK/BAS

## A P P E N D I X I:

THE LISTING OF CLAIMS (version with markings):

1. (previously presented) A layered composite useful for flooring coverings and wall panels with at least one decorative surface and consisting of a backing layer of a reinforced thermoplastic polymer which is not polypropylene, a decorative layer arranged thereupon and a heat-cured layer applied to the decorative layer, wherein a decorative layer and a heat-cured layer applied to the decorative layer are present on each side of the backing layer;  
wherein the total thickness of the layered composite is from 1 to 20 mm and the backing layer makes up at least 80% of the thickness;  
wherein said reinforced thermoplastic polymer comprises polyethylene, polyvinyl chloride, polyesters, polycarbonates, polyacrylates, polymethacrylates, polyamide, polyurethane, a polyacetal and/or polystyrenes,  
and which layered composite is prepared by  
heating said reinforced thermoplastic polymer to at least 180°C in an extruder;  
then, under a pressure of at least 80 N/cm<sup>2</sup>, introducing said heated reinforced thermoplastic polymer into an injection molding chamber of an injection molding machine into which films for the decorative layers and the heat cured layers and an optional intermediate layer have previously been placed,  
applying to the layers in the injection-molding machine a holding pressure of at least 10 N/cm<sup>2</sup>,  
while maintaining said pressure, cooling to a temperature not below 60°C for a period of not more than 4 minutes, and then  
removing the layered composite from the injection-molding chamber.
2. (canceled)
3. (currently amended) A layered composite as claimed in claim 1, [where] which further comprises an intermediate layer [is also inserted as bonding material] between the backing layer and the decorative layer, and wherein the intermediate layer is a layer of impregnated paper, a layer of a nonwoven, or a primer layer.

4. (previously presented) A layered composite as claimed in claim 1 and comprising a polystyrene backing layer.
5. (original) A layered composite as claimed in claim 1 and comprising a polybutylene terephthalate backing layer.
6. (original) A layered composite as claimed in claim 1 and comprising a polyoxymethylene backing layer.
7. (canceled)
8. (previously presented) A layered composite as claimed in claim 1, where the decorative layer is composed of a polymeric material which has an embossment or a coloration or a combination of both, or of paper or of a fabric or of a paper-like or fabric-like or wood-like material.
9. (previously presented) A layered composite as claimed in claim 1, where the heat-cured layer arranged on the decorative layer is composed of a thermosetting polymeric material, crosslinked by exposure to pressure or heat during the production of the layered composite.
10. (previously presented) A layered composite as claimed in claim 1, whose total thickness is from 5 to 10 mm and whose backing layer makes up at least 90% of the total thickness.
11. (canceled)
12. (canceled)
13. (previously presented) A layered composite as claimed in claim 1 wherein the reinforcing material of the reinforced thermoplastic polymer comprises barium sulfate, magnesium hydroxide, talc, wood, flax, glass fibers or glass beads.
14. (new) A layered composite as claimed in claim 1 which has a thickness of at least 5 mm.